

## REMARKS

### Amendments to the Claims

Applicant has canceled claims 9 and 11 and re-written claims 1-8, 10, and 12-14 as method of use claims. These amendments find support throughout the original claims and application, e.g., see page 1, lines 26-28; page 4, lines 2-4 and 18-21 and also page 5, lines 11-18. No new matter has been added. The limitations of claims 17-18 have been incorporated (in the alternative) into claim 16. Applicant has also canceled claims 17-20. These amendments are made without prejudice, without intent to acquiesce in any rejection of record, and without intent to abandon any originally claimed subject matter. Applicant reserves the right to pursue the original claims in a continuation.

### Rejection under 35 U.S.C. § 102

The rejection of claims 1-14, 16 and 19-20 under 35 U.S.C. § 102(b) as being anticipated by Beck (GB 1,407,065, hereinafter "Beck") is hereby traversed, reconsideration is respectfully requested. Claims 9, 11 and 19-20 have been canceled. Claim 16 has been amended to incorporate the limitations of claims 17 or 18. The rejection of claims 9, 11, 16 and 19-20 is therefore moot. Claim 16 is considered below with respect to the § 103 rejection of claims 17-18.

Claims 1-8, 10 and 12-14 remain. As noted, these claims have been rewritten as method of use claims, each directly or indirectly dependent on claim 1 (except for claim 14 which is independent). As amended, claims 1 and 14 relate to methods of verifying light conditions. For example, the claims cover a situation in which a user is unsure as to whether a given light condition (e.g., the light in a print shop) is the same as a light condition of interest (e.g., the light in a gallery where the print job will be viewed). In order to determine whether the light condition in the print shop and gallery are similar, the user takes an article with a pair of metameric markings that match under the gallery light and views the same article in the print shop (or vice-versa). If the markings match then the light conditions in the two locations are similar. If the markings do not match, the light conditions are different.

Beck does not teach this or any other method that falls under the scope of the pending claims. More specifically, the methods of Beck do not include each and every step of claim 1 or 14 and cannot therefore anticipate these claims (or dependents therefrom). MPEP § 2131. In particular, claims 1 and 14 each include a step of *determining whether an article is being viewed under a given light condition*. The methods of Beck do not include this step.

Beck teaches security documents with metameretic markings that match under a specific and known light condition (e.g., daylight or tungsten illumination, see page 3, lines 63-107). The methods in Beck distinguish security documents from forgeries by viewing these *under this specific and known light condition*. Thus, in Beck, the user already knows the viewing light condition but is unsure about whether the article includes metameretic markings. Since the user already knows the light condition, the methods of Beck cannot include a step of *determining whether an article is being viewed under a given light condition*. Instead, the methods of Beck include a step of determining whether the article includes metameretic markings (and is therefore a security document). In contrast, in the present claims, the user knows that the article includes metameretic markings but is unsure about the light condition. For all of these reasons, Applicant respectfully submits that claims 1-8, 10 and 12-14 are not anticipated by Beck. Withdrawal of this rejection is earnestly requested.

#### **Rejection under 35 U.S.C. § 103**

The rejection of claims 15 and 17-18 under 35 U.S.C. § 103(a) as being unpatentable over Beck in view of Hauser et al. (US 6,013,307, hereinafter "Hauser") is hereby traversed, reconsideration is respectfully requested. As noted above, claims 17-18 have been canceled and their limitations have been incorporated into claim 16. This rejection will therefore be addressed as it applies to claims 15 and 16.

The Examiner cites Hauser as teaching that the use of copier light as the lighting condition with metameretic inks/security documents was well known in the art. The Examiner then simply argues that it would therefore have been obvious for a skilled person to modify the teachings of Beck by preparing an article with metameretic markings that have the same or different color appearance under *copier light* (i.e., instead of tungsten or daylight illumination as taught by Beck).

Applicant respectfully disagrees and submits that (a) the proposed combination of references does not yield the claimed invention and (b) even if it did, a skilled person would lack the necessary motivation to make the proposed modification.

Hauser teaches a method for preventing the copying of security documents. The security documents are printed with inks that exhibit metamerism with the toners that are customarily used in copier machines (e.g., see Abstract). This causes the copier to produce copies of security documents that exhibit metamerism when compared to the originals. Of note, Hauser does not discuss the color appearance of the originals or copies *under copier*

light (e.g., see column 5, lines 7-12 where the degree of metamerism is measured under daylight and incandescent illumination). Hauser therefore fails to even teach a suitable modification to Beck's security documents. The combination of Beck and Hauser cannot yield the claimed invention.

Besides, even if Hauser did teach a suitable modification a skilled person would lack the necessary motivation to modify the security documents of Beck. As discussed previously, the security documents in Beck include metameric markings that allow these to be identified under specific light conditions. More specifically, Beck teaches that "the metameric inks used to prepare the security documents [...] should be chosen so that they exhibit their color match under illuminants *customarily employed in their inspection*" (*emphasis added*, see page 3, lines 63-67). Beck goes on to state that "daylight" (i.e., outdoor) and "tungsten illumination" (i.e., indoor) are customary *inspection* conditions (see page 3, lines 68-105). Thus, the security documents of Beck have a very particular principle of operation that includes viewing them under these customary inspection conditions. Applicant respectfully submits that based on the teachings of Beck and Hauser, copier light does not qualify as a customary *inspection* illumination. Indeed, while copier light is a customary illuminant for *copying* security documents it would seem an odd choice of illuminant for *inspecting* security documents. As stated under MPEP § 2143.01, if the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959). Here the proposed modification would cause a dramatic change in the principle of operation of Beck's security documents, namely from inspection under customary illuminants to inspection under non-customary copier light. For the same reasons, Applicant respectfully submits that a skilled person would also lack the motivation to make the proposed modification because it would render Beck's security documents unsatisfactory for their intended purpose, namely for use in inspection. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Besides, Hauser *already* teaches a method for preventing the copying of security documents thereby removing any motivation to rely on the teachings of Beck. As discussed, in Hauser, the security documents are printed with inks that exhibit metamerism with the toners that are customarily used in copier machines. This causes the copier to produce copies of security documents that exhibit metamerism when compared to the originals. The present invention prevents copying of security documents by printing originals with inks that exhibit

metamerism under copier light. This invention is different from that taught by Beck and/or Hauser.

For all of these reasons, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. Withdrawal of this rejection is also earnestly requested.

**Conclusion**

Based on the above, Applicant respectfully requests that the Examiner reconsider and withdraw all outstanding rejections and objections. Favorable consideration and allowance are earnestly solicited. Should there be any questions after reviewing this paper, the Examiner is invited to contact the undersigned at 617-248-4793. It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required for consideration of this paper (including fees for net addition of claims) are authorized to be charged in two copies of an Amendment Transmittal Letter filed herewith.

Respectfully submitted,  
CHOATE, HALL & STEWART



Charles E. Lyon, D.Phil.  
Limited Recognition under 37 C.F.R. §

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11.9(b)  
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